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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/532,911	04/27/2005	Frits Anthony Steenhof	NL 021054	4451

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PHILIPS INTELLECTUAL PROPERTY & STANDARDS
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EXAMINER

ARANI, TAGHI T

ART UNIT	PAPER NUMBER
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2131

DATE MAILED: 11/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/532,911

Applicant(s)

STEENHOF ET AL.

Examiner

Taghi T. Arani

Art Unit

2131

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 7-12 is/are rejected.
- 7) ☒ Claim(s) 4-6 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 April 2006 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 1/23/06, 4/27/05.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Taghi T. Arani
11/21/06

DETAILED ACTION

1. Claims 1-12 have been examined and are pending.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 7-11 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 7-11 are not limited to tangible embodiments. In view of applicant's disclosure, specification paragraph 0054, "such computer programs, as well as any watermarked signals generated by the embedding method of the present invention, can be stored on any machine readable medium (e.g. a computer memory, a floppy disk, a compact disc or the equivalent), or can be transmitted along any transmission medium, including both wireless and wireline medium. The term record carrier in the present specification is taken to include both such machine readable medium and such transmission medium". Therefore, The claimed "watermarking signal", record carrier and computer program are not limited to tangible embodiments, instead being defined as including both tangible embodiments and intangible embodiments (e.g., transmission medium). As such, the claims are not limited to statutory subject matter and are therefore non-statutory.

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Claim Objections

3. Claims 7-11 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-3, 7-12 are rejected under 35 U.S.C. 102(b) as being anticipated by US patent 5, 809,139 to Girod et al. (Hereinafter Girod”).

As per claims 1 and 12, Girod teaches a method and an apparatus of embedding a watermark in an information signal bit-stream, the method comprising the steps of (Figs. 1, 2A and associated texts):

receiving a portion of an information signal bit-stream (col. 4, lines 60-61, where the output of the coder 10 is input to either digital watermarking apparatus 26 or data storage device 24);

storing a first copy of the received portion in a first buffer (col. 4, lines 62-63, Data storage device 24 in which is stored a pre-compressed video signal);

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watermarking a second copy of the received portion; storing the resulting watermarked signal in a second buffer(col. 4, line 65, where the watermarking device 26 receives data from either the coder 10 directly, or from the data storage device 24 and the data is watermarked, col. 5, lines 4-6, the watermarked data is transmitted to a receiver);

performing a check at predetermined intervals to determine if the bit-rate of the received portion has been changed by being watermarked (col. 4, lines 60-65, where the output of the interframe coder 10 is input to either digital watermarking apparatus 26 or the data storage device 24, col. 6, lines 40-45, lines 54-67, where the number of bits of the encoded watermarked coefficient is tested against the number of bits of the same encoded coefficient prior to watermarking); and

outputting the first copy of the received portion from the first buffer if the check determines the bit-rate has changed, otherwise outputting the watermarked signal from the second buffer (col. 7, lines 1-16, where the Control element 46 controls selection of the output between one of two bitstreams, the original (i.e. unwatermarked) or the watermarked).

As per claim 2, Girod teaches a method as claimed in claim 1, wherein said watermarking step comprises embedding a watermark in the second copy of the received portion by transcoding (Abstract, where the disclosed digital watermarking allows for the watermarking of a digital video signal in a compressed form without requiring decoding and recoding of the signal).

As per claim 3, Girod teaches a method as claimed in claim 1, wherein said information signal comprises at least one of a transport stream and a program stream (col. 4, lines 60-65,

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where the storage device 24 is a device such as a video-on-demand (i.e. transport and program strams) server) .

As per claim 10, Girod teaches a watermarked information signal formed according to the method as claimed in claim 1 (col. 4, line 65 through col. 5, line 6, where the watermarking device 26 receives data from either the coder 10 directly, or from the data storage device 24 and the data is watermarked, see also Fig. 2A and associated text for the detailed watermarking method and apparatus).

Claims 7-9 and 11 are a computer program, a record carrier and a method of making available the computer program corresponding to method claim 1. Claims 7-9 and 11 are rejected for the same reasons provided in the statement of rejection of claim 1 above (see also Girod, col. 10, line 58 through col.11, line 9 and claims 26-36).

Allowable Subject Matter

5. Claims 4-6 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

6. Prior arts made of record, not relied upon:

US 6,208,745 to Florencio et al.

US 2003/0210651 to Tzeng et al.

US 6,639,996 to Suda.

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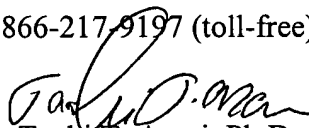
US 6,798,894 to Rhoads.

US 6,404,926 to Miyahara et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taghi T. Arani whose telephone number is (571) 272-3787. The examiner can normally be reached on 8:00-5:30 Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on (571) 272-3795. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Taghi T. Arani, Ph.D.
Primary Examiner
Art Unit 2131
11/21/2006